



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/675,438	09/28/2000	Todd O. Burger	C1068/7005	9912

7590 11/01/2004

Randy J. Pritzker
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

EXAMINER

REAGAN, JAMES A

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,438

Applicant(s)

BURGER ET AL.

Examiner

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 138-165 and 168-177 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims [14, 15, 102, 103]; [16, 17, 104, 105]; [56, 57, 58, 132, 133]; [59, 134, 135; 79, 80, 166, 167, 178]; [83, 84, 179, 85, 136, 137], drawn to a method and associated system for storing transaction information with a user authenticator between two devices transmitting secure and non-secure information, classified in class 705, subclass 67.
 - II. Claims [138-145, 170, 171]; 146-152, 172, 173]; [153-159, 174, 175]; [160-165, 176, 177]; [168]; [169], drawn to a method and associated system for managing two or more accounts encompassing two or more media utilizing an updatable database, classified in class 707, subclass 9.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as maintaining transaction records in a historical database. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).
6. During a telephone conversation with Bob Abrahamsen on 02 September 2004 a provisional election was made without traverse to prosecute the invention of Group II, claims [138-145, 170, 171]; 146-152, 172, 173]; [153-159, 174, 175]; [160-165, 176, 177]; [168]; [169]. Affirmation of this election must be made by applicant in replying to this Office action. Claims [14, 15, 102, 103]; [16, 17, 104, 105]; [56, 57, 58, 132, 133]; [59, 134, 135; 79, 80, 166, 167, 178]; [83, 84, 179, 85, 136, 137] are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

EXAMINER'S NOTE: There appear to be two consecutive claims numbered 165. For purposes of this examination the second of these two claims will be temporarily number 165(a) and addressed as such below.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 138, 146, 153, 160, 168, and 169 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lessin et al. (US 4,868,376 A) in view of Gatto (US 5,546,523 A).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claims 138, 146, 153, 160, 168, and 169:

Lessin, in at least column 1, line 1 to column 2, line 10, discloses a smart card and smart card transactions to include authentication, identification, inherent communications between the smart card, POS terminal, and associated server infrastructure, and updating the smart card after routine transactions, essentially disclosing:

(B) establishing a communication link between a controller associated with the database and a portable electronic device distinct and remotely located from the database, and transferring at least the first account information and the second account information from the database to a memory of the portable electronic device via the communication link so that at least the first account information and the second account information are caused to exist simultaneously in the memory of the portable electronic device;

(C) transporting the portable electronic device to a vicinity of a first point-of-sale (POS) terminal;

(D) when the portable electronic device is in the vicinity of the first POS terminal, manipulating a user input of the portable electronic device to select the first media for use in a first transaction at the first POS terminal;

(E) releasing at least a portion of the first account information from the portable electronic device to the first POS terminal so as to authorize the first transaction;

(F) transporting the portable electronic device to a vicinity of a second POS terminal; (G) when the portable electronic device is in the vicinity of the second POS terminal, manipulating the user input on the portable electronic device to select the second media for use in a second transaction at the second POS terminal; and

(H) releasing at least a portion of the second account information from the portable electronic device to the second POS terminal so as to authorize the second transaction.

Lessin does not specifically disclose *(A) storing at least first account information for a first media issued by a first media issuer and second account information for a second media issued by a second media issuer in a database so that the first account information and the second account information exist simultaneously in the database.* Gatto, however, in at least column 11, lines 24-25 and line 54 discloses a smart card that contains multiple accounts. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lessin with Gatto because multiple accounts on one card increases user efficiency.

9. Claims 139-145, 147-152, 154-159, 161-165, 165(a), 170, 172, 174, and 176 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lessin/Gatto in view of Angelo et al. (US 6,182,892 B1).

Claims 139, 147, 154, 161, 170, 172, 174, and 176:

The combination of Lessin/Gatto discloses the limitations as shown above. Lessin/Gatto do not specifically disclose:

- *the step (E) comprises causing a token to embody at least the portion of the first account information, and separating the token from the portable electronic device so that, after separation, the token may interface with the first POS terminal to transfer at least the portion of the first account information to the first POS terminal; and*
- *the step (H) comprises causing the token to embody at least the portion of the second account information, and separating the token from the portable electronic device so that, after separation, the token may interface with the second POS terminal to transfer at least the portion of the second account information to the second POS terminal;*

Angelo, however, in at least column 1, lines 42-56 discloses detachable and therefore releasable attachments, as well as inherently disclosing magnetic stripe readers essential to POS machines. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lessin/Gatto with Angelo because a releasable attachment provides flexibility of use.

Claims 140-143, 148-151, 155-158, and 162-165:

With regard to the limitations of:

- *employing a user-authenticator included in the first portable electronic device to authenticate an identity of a user of the first portable electronic device; and*
- *enabling each of the steps (E) and (H) to be performed only after the user authenticator has authenticated the identity of the user;*

- *measuring a biometric characteristic of the user of the portable electronic device;*
and
- *comparing the measured biometric characteristic with a representation of a biometric characteristic stored in memory of the portable electronic device.*

Lessin, in at least column 4, line 10, discloses the use of biometric identifiers.

Claims 144, 152, 159, and 165(a):

The combination of Lessin/Gatto discloses the limitations as shown above. Lessin/Gatto do not specifically disclose *the first and second media issuers are unrelated*. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate multiple accounts on one smart card that were not affiliated with each other, such as, for example VISA® and MASTERCARD® because multiple accounts on one card increases user efficiency.

Claim 145:

With regard to the limitations of:

- (A) *storing at least third account information for a third media issued by a third media issuer and fourth account information for a fourth media issued by a fourth media issuer in the database so that the first account information, second account information, third account information, and fourth account information exist simultaneously in the database;*
- (B) *establishing a communication link between the controller associated with the database and a second portable electronic device distinct and remotely located from the database, and transferring at least the third account information and the fourth account information from the database to a memory of the second portable electronic device via the communication link so that at least the third account information and the fourth*

account information are caused to exist simultaneously in the memory of the second portable electronic device;

(C) transporting the second portable electronic device to a vicinity of a third point-of-sale (POS) terminal;

(D) when the second portable electronic device is in the vicinity of the third POS terminal, manipulating a user input of the second portable electronic device to select the third media for use in a third transaction at the third POS terminal;

(E) releasing at least a portion of the third account information from the second portable electronic device to the third POS terminal so as to authorize the third transaction;

(F) transporting the second portable electronic device to a vicinity of a fourth POS terminal;

(G) when the second portable electronic device is in the vicinity of the fourth POS terminal, manipulating the user input on the second portable electronic device to select the fourth media for use in a fourth transaction at the fourth POS terminal; and

(H) releasing at least a portion of the fourth account information from the second portable electronic device to the fourth POS terminal so as to authorize the fourth transaction.

See the rejection of claims 138, 146, 153, 160, 168, and 169 as shown above. It would have been obvious to one of ordinary skill in the art at the time of the invention to include third and fourth accounts because multiple accounts on one card increases user efficiency.

10. Claims 171, 173, 175, and 177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lessin/Gatto/Angelo in view of Postlewaite et al. (US 5,854,891 A).

Claims 171, 173, 175, and 177:

The combination of Lessin/Gatto/Angelo discloses the limitations as shown above. Lessin/Gatto/Angelo do not specifically disclose causing a simulated magnetic stripe to be generated on the token. Postlewaite, however, in at least column 2, lines 20-56 discloses virtual smart cards. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Lessin/Gatto/Angelo with Postlewaite because a virtual smart card system enables computer users to use multiple smart cards during the normal operation of their computer without inserting a plurality of physical smart cards into a smart card reader (Postlewaite, column 2, lines 20-23).

Application/Control Number:
09/675,438
Art Unit: 3621

Page 10

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including

After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED"

or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR

14 October 2004

